

REMARKS

The Office examined claims 1-8, 10-21, and 25-29, and rejected same. With this paper, none of the claims are amended, none are canceled and none are added.

Claim Rejections under 35 USC §103

Claims 1-4, 6-7, 17 and 25-29 are rejected under 35 USC §103(a) as being unpatentable over Nilsson (U.S. Patent No. 6,400,967, Nilsson hereinafter) in view of Cockerill *et al* (U.S. Patent No. 6,503,005, Cockerill hereinafter).

Claims 5, 8, 11-16, and 18-21 are rejected under 35 USC §103(a) as being unpatentable over Nilsson in view of Cockerill and further in view of Kubo (U.S. Patent No. 6,580,923).

Applicant respectfully disagrees with the Examiner's rejection of claims to the effect that there is insufficient basis for combining or modifying Nilsson in view of Cockerill. There is, in this case, insufficient basis for a *prima facie* case of obviousness.

First, the subject matter of Nilsson is about mobile keyless telephone instruments. The mobile keyless telephone of Nilsson is very compact in size, and features voice dialing and voice programming capabilities (see Title). In the specification, Nilsson states that:

The basic simplicity of instruments in accordance herewith enable very compact telephone instrument forms, as in the configuration of a fountain pen, e.g., simply an elongated cylinder of less than one inch diameter. In large production runs, individual instruments may be quite inexpensive, even to the extent of being discardable or disposable when the original pre-paid value has been consumed. However, in accordance herewith, individual instruments, along with their enabling system may be implemented to facilitate extended use. For example, as a result of aspects hereof, individual instruments may be effectively reactivated or recycled to extend their useful life (col. 4, lines 19-31).

Therefore, it has never been Nilsson's teaching or suggestion to add a keymat onto the mobile keyless telephone. In fact, Nilsson teaches using the voice dialing and voice programming capabilities of the compact mobile telephone in order to avoid such a basic requirement for a conventional mobile telephone.

Second, Cockerill teaches a hand-held tape printing device that comprises a plurality of keys. The keys are received by a keyboard casework with a plurality of apertures in one face. However, the invention of Cockerill has nothing in common with a mobile telephone, i.e. it has none of the functionalities of the compact mobile telephone of Nilsson. Cockerill neither teaches nor suggests modifying the hand-held tape printing device so it can be used as a mobile telephone.

Therefore, applicant respectfully reasserts that, the combinations made in the Office action are improper. To combine references, as set out in the MPEP at 706.02(j), the Office must establish a *prima facie* case of obviousness, which requires first, that there be "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," second, that "there must be a reasonable expectation of success," and third, that the combination made in the Office "teach or suggest all the claim limitations."

The Office asserts that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Cockerill into view of Nilsson in order to make the cellular phone in the form of small and inexpensive as suggested by Nilsson . . ." Applicant regards such an assertion not as providing an element of a *prima facie* case of obviousness, and respectfully reasserts that the combinations made in the Office action are made purely in hindsight. It is noted that the "hindsight syndrome", as was notably expounded upon *In re Kotzab*, 217 F.3d 1365, 55 USPQ 2d 1313 (Fed Cir. 2000), must be avoided when considering obviousness. It is thus critical in analyzing the patentability of the present invention to cast the mind back to the time of invention to consider the thinking of an ordinary person skilled in the art and guided only by prior art references and the wisdom in the field. It follows in this case that one skilled in the art would not have combined the cited references Nilsson and Cockerill.

For the above reasons, applicant respectfully submits that there is no objective teaching in the prior art or general knowledge in the art that would lead a person skilled in the art to combine the teachings of Nilsson and Cockerill. Accordingly, a *prima facie* case of obviousness is not established in this case, and it follows that the above rejection of all claims based on 35 USC §103 are improper and should be withdrawn.

Conclusions

For all the foregoing reasons it is believed that all of the claims of the application are now in condition for allowance, and their passage to issue is earnestly solicited. Applicant's agent urges the Examiner to call to discuss the present response if there are any questions.

Respectfully submitted,

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